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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,011	03/08/2007	Christ J. Pavlatos	26880-100961	1220
23644 7590 07/18/2011 BARNES & THORNBURG LLP P.O. Box 2786 CHICAGO, IL 60690-2786				
EXAMINER PHONGSVIRAJATI, POONSIN				
ART UNIT 3686		PAPER NUMBER		
NOTIFICATION DATE 07/18/2011		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Patent-ch@btlaw.com

### Office Action Summary

**Application No.**

10/595,011

**Applicant(s)**

PAVLATOS ET AL.

**Examiner**

SIND PHONGSVIRAJATI

**Art Unit**

3686

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 April 2011.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 and 8 is/are pending in the application.  
4a) Of the above claim(s) none is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-4 and 8 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsman's Patent Drawing Review (PTO-940)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

1. In response to communication filed on 04/01/2011, claims 1 is currently amended, claim 5-7, 9-30 are canceled. Claims 1-4, and 8 are now pending.

### ***Claim Rejections - 35 USC § 112 First Paragraph***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The 112(1) paragraph rejection to claims 1-4, 6, 8-9, 11-13, 15, 18-20, 22-28 are withdrawn given Applicant's amendments/cancellations.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4, and 8, are rejected under 35 U.S.C. 103(a) as being unpatentable over Edelson et al. (US 5,737,539) in view of Kozic (US 2003/0179287) in further view of Rao (US 2003/0177038).

3. As to **Claims 1**, Edelson teaches of an interface for use in accessing a repository server by a healthcare provider, the interface comprising: a repository server including health-related information of a plurality of patients (Abstract, col. 8 lines 20-31); an interface adapted to facilitate access to the health-related information on the repository server, wherein the interface includes: at least one patient health record section adapted to display health-related information of a selected patient retrieved from the repository server (Abstract, Fig. 2, 3, col. 8 lines 20-31), and a banner section being operative to display information based on the content of the patient health record section, wherein the banner section includes a communications portal for hosting a communications session with a drug provider that is selected based on prescription information in the patient health record section (Fig. 3, col. 19 lines 36-60, col. 26 line 56 to col. 27 line 29). However, Edelson does not specifically disclose the communication session being an interactive communication portal session and the interface being a web-based interface. Kozic does teach of a web-based interface and an interactive video conferencing function for providing pharmaceutical services to remote sites (paragraphs 12-14). It would have been obvious to one of ordinary skill in the art at the time of the invention to have an interactive communication session within the teachings of Edelson for the motivation for incorporating interactive computer-assisted decision making (Edelson, col. 50 lines 44-53).

The combination of Edelson and Kozic does not specifically disclose the banner section further comprising an alert banner configured to display a commonly

misdiagnosed illness responsive to one or more medical conditions in the patient health record section. Rao does teach of an interface that alerts of potential misdiagnosed illnesses at a particular time and place responsive to one or more medical conditions in the patient health record section (paragraph 11). It would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated the feature of alerting to misdiagnosed illnesses within the teaching of Edelson for the motivation for giving the correct diagnosis to the patient.

4. As to **Claim 2**, Edelson teaches of the banner section further comprising a prescription ordering template related to prescription information in the patient health record section (col. 19 lines 26-35).
5. As to **Claim 3**, Edelson teaches of the interface of claim 1, the banner section further comprising a product ordering template related to information in the patient health record section (col. 19 lines 26-35).
6. As to **Claim 4**, Edelson teaches of the interface of claim 1, the banner section further comprising drug information related to the prescription information in the patient health record section (col. 19 line 28).
7. As to **Claim 8**, Edelson teaches of the banner section further comprising physician-customizable drug advertising (Fig. 14).

***Response to Arguments***

8. Applicant's arguments filed 04/01/2011 have been fully considered but they are not persuasive.

As to Applicant's argument to the 112(1) rejection, Applicant alleges:

First, the Examiner contended that the limitation in Claims 1 and 20 in which the drug assistance request template is automatically populated "based on the detection by the web-based interface that the patient qualifies for a drug assistance program" does not have support in the specification. Applicant respectfully disagrees. For example, the specification states that the banner section "performs health assistance-related functions based on the content of the health record section." Although the term "detect" is not explicitly used in the specification, Applicant respectfully submits that this disclosure of "assistance-related functions based on the content of the health record section" at least implicitly supports the "detection" limitation in Claims 1 and 20.

However, Examiner did not invoke a 112(1) rejection based on the absence of the term, "detect". Examiner rejected the previous limitation,

wherein the banner section includes a drug assistance request template, the drug assistance request template being automatically populated generated with a patient's health information based on the detection by the web-based interface that the patient qualifies for a drug assistance program

because Applicant did not have possession of this feature at the time the application was filed. Applicant states that the specification discloses "assistance-related functions based on the content of the health record section", however, this broad recitation is not

equivalent to "the template being populated with the patient's health information **based on the detection by the web-based interface that the patient qualifies for a drug assistance program**". Applicant still hasn't provided any recitation in the application that remotely discloses that the patient's health information is based on the detection by the web-based interface **that the patient qualifies for a drug assistance program**. Due to Applicant's deletion of the amendment, Applicant's argument is now moot.

Next, Applicant alleges:

Second, the Examiner asserted that the limitation in Claim 11 in which a communications session with a selected drug provider is made "at a network address associated with the selected drug provider" is not specifically disclosed. Although the Examiner admitted that it is at least questionable whether a network address is implicitly or inherently disclosed, the Examiner contended that Applicant has specifically relied on this limitation as overcoming the prior art. Applicant respectfully disagrees that there was a specific reliance on a "network address"; instead, the thrust of Applicant's argument was that the Kozic reference only supported a central pharmacist in which all remote locations connected to the same location,

However, Examiner is unclear of Applicant's interpretation of the prior art, the central pharmacist may select which remote site (e.g. pharmacy, drug store) the central pharmacist would like to communicate with. As stated many times within Kozic,

The central site may be, but is not limited to, one of the plurality of remote sites.

Therefore, the video conference function is not limited to a one-to-many relation of video conferencing communication but rather a many-to-many relation. Nevertheless, Kozic does teach that an interactive communication session is made with a selected one of multiple drug providers even if there was only a one-to-many relation of video conferencing from a central site to a plurality of remote sites. Again, Examiner is unclear of the thrust of Applicant's argument. Specifically, how Applicant interprets that Kozic only supports a central pharmacist connected to all remote locations at the same location. In other words, how are the **remote** sites at the **same** location? The remote sites are all connected through network communication by means of the internet.

As to Applicant's argument to the 103 rejection, Applicant alleges:



The Examiner acknowledged that the combination of Edelson, Kozic, and Kaker does not disclose the alert banner configured to display a commonly misdiagnosed illness responsive to one or more medical conditions in the patient health record section. However, the Examiner relies on Rao for this limitation. Assuming *arguendo* that one wanted to combine Edelson, Kozic, Kaker and Rao, the resulting combination would not disclose all limitations of amended Claim 1. To establish a *prima facie* case of obviousness, all the claim limitations must be taught or suggested by the prior art. See MPEP § 2143.03. As discussed below, the alert banner recited in amended Claim 1 includes limitations not disclosed or suggested by Rao.

The alert banner recited in Claim 1 is presented to the patient's physician at the point of care based on the patient's medical record to potentially alter the physician's diagnosis. As explained in the specification, "the alert may be activated when one or more of the medical conditions shown for the current patient have been flagged ... A doctor reviewing the alert may realize that a misdiagnosis has been made and change their prescribed treatment." In other words, this is a tool that the physician uses at the point of care to reduce the possibility of a misdiagnosis.

However, Applicant's argument is based on importing limitations from the specifications into the claim. Limitations appearing in the specification but not recited in the claim should not be read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily). *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550- 551

(CCPA 1969). See also *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (MPEP 2106).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SIND PHONGSVIRAJATI whose telephone number is (571) 270-5398. The examiner can normally be reached on Monday - Thursday 8:00am-5:00pm (ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/S. P./  
Examiner, Art Unit 3686

29 June 2011

/Gerald J. O'Connor/  
Supervisory Patent Examiner  
Group Art Unit 3686